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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,309	02/21/2002	Michael Brandt	20859	3846
151	7590	09/02/2005	EXAMINER	
HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110			CHANDRA, GYAN	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,309

Applicant(s)

BRANDT ET AL.

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Examiner

Gyan Chandra

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3,7 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/29/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

S.O.O

DETAILED ACTION

Status of Application, Amendments, And/Or Claims

Applicants have confirmed Restriction/Election made on December 22, 2004. Therefore, the Restriction/Election is made final.

The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

Information Disclosure Statement

The information disclosure statement filed 2/21/2002 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Rejections/Maintained

Claim Rejections - 35 USC § 103(a)

The rejection of claims 1-2, 4-6, 8, and 12-13 under 35 U.S.C. 103(a) as being unpatentable over Namiki et al in view of Date et al and Gaertner et al, is maintained for reasons of record in the previous Office Action.

Art Unit: 1646

Applicants argue that Nimiki et al only teaches the modification of HGF by attaching PEG(s) at the N-terminus amino acids to improve the clearance in vivo pharmacokinetics of HGF but they do not teach (a) the modification of NK4, (b) adding a monoethoxy linear PEG, and they do not teach adding a PEG of molecular weight 20-40kDa. Applicants' argument has been fully considered but is not found to be persuasive because Nimiki et al teach that the modification of HGF by attaching monoethoxy linear and branched PEG(s) at the N-terminus amino acids to improve the clearance and in vivo pharmacokinetics of HGF and Date et al teach that HGF comprises a four-kringle-containing (NK4). They teach that the NK4 is a 59 kDa protein. Further, Gaertner et al teach attaching PEG at amino terminus of proteins and suggest that a PEG in size from 5 to 40 kDa should be attached to a protein for an improved bioavailability. The skill of art is high and it would have been prima facie obvious to the person of ordinary skill in the art at the time the invention was made to attach PEG molecules in the range of molecular weight 5-40 kDa (as suggested by Gaertner) to the N-terminus amino acid of NK4 in order to increase clearance and pharmacokinetics of the molecule.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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The rejection of claims 14-15 under 35 U.S.C. 103(a) as being unpatentable over Namiki et al in view of Date et al and Gaertner et al as applied to claims 1-2, 4-6, 8, and 12-13 above, and further in view of Veronese et.al, is maintained. Applicants argue that because the rejection of claims 1-2, 4-6, 8, and 12-13 under 35 U.S.C. 103(a) does not hold therefore, claims 14-15 are in condition for allowance. Applicants' argument has been fully considered but is not found to be persuasive for the reasons of records and as set forth supra.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gyan Chandra whose telephone number is (571) 272-2922. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on (571) 272-0829. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gyan Chandra
AU 1646
25 August 2005


JANET L. ANDRES
SUPERVISORY PATENT EXAMINER